

## Remarks

A. The Examiner has objected to claim 9 because the use of “partially” renders the claim indefinite.

Response:

Claim 9 has been amended to eliminate use of the term “partially”.

B. The Examiner has rejected claim 7 under 35 U.S.C. 112, 2<sup>nd</sup> paragraph, as being indefinite as a single claim to both an apparatus and a method of using the apparatus, and therefore under 35 U.S.C. 101 because it embraces two different statutory classes of invention.

Response:

Applicant strongly disagrees with the characterization of claim 7 that it is a claim for both an apparatus and a method. By amendment, applicant has condensed the functional statement. However, the instant claim 7 merely recites one functional step within an entirely concise apparatus claim, which function naturally flows from the recited structure.

MPEP 2173.05(g) defines and also permits functional statements in a claim:

A functional limitation is an attempt to define something by what it does, rather than by what it is (e.g., as evidenced by its specific structure or specific ingredients). There is nothing inherently wrong with defining some part of an invention in functional terms. Functional language does not, in and of itself, render a claim improper. *In re Swinehart*, 439 F.2d 210, 169 U.S.P.Q. (BNA) 226 (C.C.P.A. 1971). See also *In re Ludtke & Sloan*, 169 U.S.P.Q. (BNA) 563 (C.C.P.A. 1971). (the structural claim contained “providing. . .”, “creating. . .”, “whereby. . .”, “such that. . .” and “thus. . .” functional clauses to show the ultimate effect and desired result of a parachute canopy)

The Examiner cites *Ex parte Lyell* to substantiate this rejection, but clearly claim 7 is distinguishable from the claim at issue in that case. Claim 2 in *Lyell* read:

2. An automatic transmission tool in the form of a workstand *and method for using same* [emphasis added] comprising:

a support means,  
and [sic] internally splined sleeve affixed upright to said support means,  
a threaded adjustment bolt threadably engaged through a hole in the  
bottom of said support means and projecting upward through said support  
frame into said sleeve,

and further comprising the steps of

1. **positioning** the output end of an automatic transmission onto said upright sleeve,
2. **removing** the internal components of said automatic transmission from the casing of said transmission,
3. **repairing** and replacing said internal components back into said casing, and
4. **adjusting** said internal components for fit and interference by means of adjusting said upwardly projecting adjustment bolt.

Notably, the above claim contains clear method steps within the body of an apparatus claim, and even the preamble recites both an apparatus and a method. In fact, one-half of the claim is for a structure, and an almost identical number of steps recite clear method steps. As the board stated, this would cause confusion as to who potentially could be an infringer. A claim must be clear from its wording that it is drawn to one or the other of these mutually exclusive statutory classes of invention. *Id.*

The instant claim 7 merely recites a single functional step within an apparatus claim. Claim 7 is drawn exclusively to a structure. "There is never any objection to functional statements that merely set forth the movements, actions, or results that necessarily follow from the structure previously recited."<sup>1</sup> In fact, in some instances a "whereby" clause that merely states the result of the limitations in the claim adds nothing to the patentability or substance of the claim<sup>2</sup>. *Tex. Instruments, Inc. v. United States Int'l Trade Comm'n*, 988 F.2d 1165 (Fed. Cir. 1993). Here, the functional statement at the end of claim 7 merely sets forth the resulting action of the longitudinal grooves holding the guide wire at the base of the projections, which is an entirely appropriate functional limitation within an apparatus claim.

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<sup>1</sup> See Faber, Robert C., *Landis on Mechanics of Patent Claim Drafting*, 4<sup>th</sup> Edition, § 30 (2002).

<sup>2</sup> On the other hand, novelty in a claim *can* exist where the novelty resides solely in a functional statement. *In re Echerd & Waters*, 176 U.S.P.Q. (BNA) 321 (CC.P.A. 1973).

C. The Examiner has rejected claims 1 -12 under 35 U.S.C. 103(a) as being unpatentable over Yoshikawa (US D 333,182) in view of Christensen et al. (US 2003/0229297 A1).<sup>3</sup>

Response:

Enclosed herewith is an affidavit by applicant filed pursuant to 37 CFR 1.131. The affidavit avers facts which substantiate an earlier date of invention, which invention date pre-dates the effective filing date of Christensen et al., which discloses but does not claim the features of a “horizontally defined proximal slit disposed within half the width of the flap hinge; a vertically defined distal slit disposed within half the length of the clamping tongue; and the wire channel projections having longitudinal grooves disposed therein.” Furthermore, applicant’s affidavit proves diligence from the time of conception to the time of constructive reduction to practice (filing). Therefore, applicant has sworn back of the Christensen reference, and Christiansen can no longer be considered prior art. As a result, applicant’s invention can no longer be considered obvious solely under the reference to Yoshikawa.

Regardless, claim 1 has been amended to include the limitation of “wherein said torquer can be removed from said guidewire without having to slide said torquer off an end of said guidewire.” This is what the feature of the horizontal slit within the flap hinge allows. The open end of the slit allows the torquer to be placed on the guidewire without having to thread the far end of the guidewire through the torquer. Both Yoshikawa and Christiansen require this because the guidewire is mounted within a central hole and passage of the device, for instance by lining up the end of the guidewire and sliding it through the device. Specifically, as noted in Christiansen, a plurality of fingers encircle the elongated member (guidewire) *when it is threaded through the central passage of the device*. See paragraph [0009], [0021], and fig. 3, label 21, showing the central holes. The prior art discloses only central, circular passages, which, as applicant points out in his specification, requires the device be positioned by threading the guidewire onto the device, all the way at the guidewire’s end. This can be quite

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<sup>3</sup> The Examiner indicates further that the application currently names joint inventors. This is incorrect. There is only one inventor named.

cumbersome and time-consuming during surgical procedures. Having a horizontal slit defined within half the width of a flap hinge eliminates this problem because the torquer device can be placed at any location along any point of the guidewire and still allows the guidewire to be positioned medially within the device. Claim 1 now better emphasizes this feature, which is not shown or made obvious by the prior art. Support for this limitation can be found in applicant's specification at page 9, lines 3-5; page 10, lines 8-11.

Finally, although Christiansen has been sworn back of, claim 7 has been amended to include the limitation of the longitudinal grooves being defined *at the base* of the projection. This is how the guidewire can be nested while still allowing the guidewire to rotate freely and move longitudinally within said torquer when in an unlocked position, and further prevent the torquer from falling off the guidewire when in an unlocked position. This feature is not taught or suggested by Christiansen and the prior art. Specifically, the recesses on the projections of Christiansen are on the surface of the projections, and because they are not at the base of the projections, they do not serve to retain the torquer when it is opened. In fact, the device of Christiansen will always remain on the guidewire when opened because the guidewire is held within the central passage discussed above. The longitudinal grooves at the base of the projections, in combination with the open, horizontal slit, are novel and unobvious features in applicant's claims. The longitudinal grooves being at the base of the projection are shown in figure 1.

## CONCLUSION

Independent claim 1 distinctly claims both the horizontally defined proximal slit traveling half the width of the flap hinge, which allows "side-mounting" of the torquer along the guidewire; and the vertically defined distal slit within the clamping tongue. These features are not made obvious by the prior art. Alternatively, even if these features are considered obvious in view of Christiansen, Christiansen has been sworn back of and is no longer prior art. Claims 2 - 6 rise or fall with claim 1.

Independent claim 7 distinctly claims a wire channel means embodiment which includes alternating projections, with each projection having a longitudinal groove (or

detent) at the base of the projection, whereby said guidewire can be nested while allowing the guidewire to rotate freely and move longitudinally within said torquer when in an unlocked position. Thus, this claim is no longer considered obvious in view of the prior art. Alternatively, only Christiansen suggests such a feature, and Christiansen has been sworn back of. Claims 8 -12 are dependent from claim 7.

Accordingly, it is respectfully requested that this amendment and response be entered. Entry and consideration of the Rule 131 affidavit is also respectfully requested. Claims 1 – 12 are allowable under 35 U.S.C. §112 and are no longer considered obvious under 35 U.S.C. §103. Should other informal matters remain before a notice of allowance is issued for this case, please let me know. Thank you for your attention to this matter.

Respectfully submitted,  
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